

REMARKS

This application relates to a novel sealed package of film for producing framed photographs.

The Examiner's comments about the need for a drawing have been noted but it is requested the drawing, and the expense related thereto, be deferred until there is an indication of allowable subject matter, probably before the Examiner would otherwise issue a notice of allowability.

Reconsideration is requested of the rejection of all the claims under 35 USC 101 as directed to non-statutory subject matter. Claim 1 is directed to far more than a blank page with printed matter. Further, the bar is with regard to the particular identity of the printed matter, not the concept of some printed matter is not per se barred.

Further, it is the relative exposure (exposed and unexposed) which here is an essential feature.

Reconsideration is requested of the rejection of all the claims under USC § 103 as being unpatentable over Spector ('832), Spector ('224) and Kirkendall.

Respectfully, the fact that the references fail to disclose:

"a pre-exposed border.....in an instant type film unit"

says it all. They are non-pertinent. That is the present invention. For that the Examiner provides no reference.

Returning to the references, they will now be discussed in much greater detail, the italicized material being taken from the reference texts, viz:

SPECTOR ('832)

From Title:

PHOTOGRAPHIC TECHNIQUE FOR PRODUCING PICTURES OF INDIVIDUALS JOINTLY WITH CHARACTERS

From Column 2, Lines 1-8:

"In view of the foregoing, the main object of this invention is to provide a photographic technique for producing a picture in which an individual whose picture is taken is seen together with a figurative character in such a way as to establish an apparent relationship there between."

From Abstract:

"When the camera is set to place a particular frame behind the lens, the individual is then posed before the camera to occupy a predetermined position relative to the latent frame image."

DISSIMILAR:

- Only pictures of people can be taken with this invention, if it is to make sense. Pictures of scenery and objects would make no sense and go against the "essential spirit" of the inventions (see patent *Title* above). The applicant's invention has no such restrictions. The subject can be a person, an object or a scene, and the border can be of anything, including people like Ronald McDonald, and still make sense.

- The pre-exposure is of a figurative, human-like character. In the applicant's invention, the pre-exposure is of a border, not a figurative, human character, and thus less restrictive.
- There is an inherent, controlling relationship between Spector's invention and the person who's photo is being taken by it. Spector's invention works like a script. The successive frames containing varied, pre-exposed, pre-determined positions of the figurative character force the subject (a child) to act, or pose, in different ways in accordance with the figurative character so as to "establish an apparent relationship". The subjects location and distance from the camera is also dictated by the film. The subject, or child, should face the figurative character, be located close to it and be of the same approximate height (i.e. distance from the camera) so that one does not tower over the other (see figs. 1&2, Spector '832). The series of varied character and subject poses results in the creation of a figurative story line in pictures. The intent to create a scripted story line is buttressed by Spector's suggestion that the series of finished pictures may be placed in a book in which the subject (a child) can be encouraged to write a story line to fit each differing shot (see Fig. 5, Spector '832). The scripted, pre-exposed film dictates the subject matter, its location, its distance from the camera and its action, much like a script. The applicant's border makes no such demands of its subject(s).

Column 2, Lines 12-13:

"a...camera...which is loaded by film whose successive frames are partially pre-exposed so that each frame contains a latent image of a character"

Column 3, Line 4-9:

"Each frame in the sequence thereof is partially pre-exposed to produce a latent image of a character. It is essential that the film frame only be partially pre-exposed (i.e. half a normal full exposure), so that the same frame remains sensitive to light and can be further exposed to photograph the individual."

Column 4, Line 8-16:

"Since the film is pre-exposed, usually to about one half of its normal full exposure period for taking a picture, and the exposure of the film is completed when taking a picture of an individual, the resultant picture would under ordinary circumstances be somewhat underexposed both as to the character and the individual. But by the use of a film of the appropriate sensitivity, this underexposure can be compensated for to provide a picture of good quality."

Because Spector is not using masks, the only way for him to get his two different exposures (character and a child) on a single frame of film is to expose the whole, entire area of a single frame twice, first to the character, then to the subject, a child. Spector is not very clear on his method, but the applicant has deduced two from Spector's text and that of Kirkendall ('512).

Method #1:

As mentioned above, Spector exposes the whole, entire area of a single frame twice, first to the pre-exposure, then to the second exposure. Under normal circumstances, this will cause two problems:

Problem #1)

Double Exposure: the image from the second exposure will appear transparently on top of the image from the first exposure. For example, if the child (the second exposure) is shot too close to the pre-determined location of the character (the pre-exposure), then the child will appear on top of and transparent to the character and ruin the picture.

Problem #2)

Film Saturation/Sensitivity: film sensitivity is like a sponge with water. A film frame can only absorb a certain amount of light before it reaches its limit and is completely saturated and unable to absorb any more. Thus, if Spector exposes the entire area of each frame twice, the film will just about reach its light saturation point after the first exposure with no room left to absorb light from the subsequent second exposure.

A "Solution":

In an attempt to fix this, Spector cuts the exposure times of the first and second exposures in half. For example, the first image is exposed to the entire frame at 1/2 the normal exposure time of a regular picture. This means that only 1/2 the normal amount of light is impinging on the entire frame. Thus, the frame has not been fully saturated with light to its limit and can accept another successive, 1/2 exposure time till it is saturated. Thus, the second image, exposed to the same entire frame at 1/2 the normal exposure time, is readily absorbed (i.e. 1/2 exposure time + another 1/2 exposure time = 1 full exposure). This fixes Problem #2. As for Problem #1, since 1/2 the amount of light from each image/exposure impinges on the entire frame, the images are weaker and thus less likely

to overpower each other and appear over one another, and coupled with Spector's viewfinder guides, overlapping the character with the child is hopefully avoided. **But this solution leads to:**

Problem #3):

Under Exposure: Since the 1st and 2nd exposures to each frame contain only 1/2 the amount of normal light, their images are weaker and appear dimmer than normal when developed. This is called under exposure. Spector admits this problem and suggests the use of a film of an "appropriate sensitivity" (i.e. higher sensitivity) to "compensate" for this problem. It is unlikely it solves any of Spector's problems at all.

Method #2:

As in Method #1, Spector exposes the whole, entire area of a single frame twice, first to the pre-exposure, then to the second exposure. But in this method, only the first exposure time is halved, the second exposure remains normal (i.e. 1/2 exposure time + 1 full exposure time = 1 1/2 exposure). As Kirkendall ('512) *Column 2, Line 20-25* explains: *"The technique used by Spector is not one of using a mask over a portion of the film unit, but rather exposing the whole film unit frame twice, first by an under-exposure based on light and timing and later by a full exposure of the primary object to be photographed"* [i.e. the second exposure]. This method ends up with the same problems as Method #1 with Spector again suggesting the use of a more sensitive film to compensate for his under exposures. Again, the applicant doubts if it solves any of Spector's problems at all.

SIMILAR:

- Spector's intention is to have a pre-exposed image and a contiguous image from a second exposure develop simultaneously; so does the applicant's invention.
- Spector uses successive, partially pre-exposed frames as does the applicant's invention, although Spector's "partial" exposure method is not the same as in the applicant's invention.
- Spector suggests that his method can be employed with Polaroid film packs, the applicant's invention suggests the same, although the applicant believes Spector's method is more suited to the Kodak camera type and that's why it is cited and illustrated in Spector's patent, and less suited to the Polaroid film packs which are used in a wide variety of Polaroid camera designs that would thus require a wide variety of more complex "viewfinder guide" designs used in Spector's invention and thus hamper its goal of simplicity that even a child could understand and use and thereby deviate from "the essential spirit" of the invention.

DISSIMILAR:

- Spector's method of pre & post exposing differs greatly from the applicant's.
- For Spector, the above phrase "partially pre-exposed" refers to "partial" (vs. full) exposure times, and not to "partial" areas of the film frame as in the applicant's invention.
- Spector does not mask the film, the applicant's invention does mask the film.
- Spector pre-exposes the entire frame; the applicant uses a mask and pre-exposes only a selected area (the border).

- Spector exposes the entire frame, again, in the second exposure; the applicant uses a mask and exposes only a selected area (the center) in the second exposure.
- Spector exposes the whole, entire area of each and every successive frame twice; the applicant uses a mask and exposes each area only once (see above two points).
- Spector's method runs the possibility of causing double exposures (because he doesn't use masking), whereas in the applicant's invention it is impossible to get double exposures.
- Spector's invention runs the possibility of causing film saturation, whereas here it is impossible to get film saturation.
- Spector's invention runs the possibility of causing under exposure, whereas in here it is impossible to get under exposures.
- Spector's invention makes no masking modification to the film cartridge; and can here be done.
- Spector's results are inferior to and differ greatly from the applicant's, as believed.

Column 2, Lines 9-11:

"More particularly, an object of the present invention is to provide a technique of the above type which makes use of a conventional camera..."

Column 2, Lines 14-17

"Also an object of the invention is to provide a camera for carrying out this technique which includes a viewfinder adapted to receive a movable strip having a succession of transparent slides thereon corresponding to..."

The similarities and dissimilarities regarding the above depend upon which method one believes Spector is using, Method #1 or #2. The applicant has divided his comments accordingly.

Under Method #1:

(1st exposure done at 1/2 exposure time, 2nd exposure done at 1/2 exposure time)

DISSIMILAR:

- This invention does not make use of a conventional camera, as it claims. Spector's Method #1 dictates that the 2nd exposure be exposed at 1/2 the normal exposure time of a regular camera/picture. This is the exposure done by the person taking the picture, not the pre-exposure done by the factory. Thus, Spector is really suggesting the use of a specialized camera that automatically knows it must cut its 2nd exposure time in half to fit the film. This is not a characteristic of a "conventional", off the shelf camera. Alternately, this camera cannot be loaded with regular, non pre-exposed film to take normal, everyday pictures for it is set for 1/2 exposure times, it can only take these special pictures and thus is not a "conventional" camera. A professional camera could accommodate such exposure time adjustments, but that type cannot be used by a child and departs significantly from "the essential spirit" or intended simplicity of Spector's invention, i.e. *Column 1, Lines 27-36*: "Low-cost...disposable cameras [which] are particularly popular with young children; for to operate the camera no training or skill is required, and all the child need do is to compose a picture through the viewfinder and then snap it.

- Spector uses a special "viewfinder" containing guide strips pre-printed with the character upon them. This is done to ensure proper alignment of the two images and avoid double exposing them, i.e. avoid their overlaying each other. Such a "viewfinder" is hardly part of any "conventional" camera and makes it specialized. It is obvious that the consumer is intended to buy this special, "disposable" camera that already has the viewfinder on it and the film in it. The invention is not presented as a case of the consumer buying only the special, pre-exposed film and dropping it into a regular conventional camera that he or she might have at home. Thus, this viewfinder makes this camera not a "conventional" camera, but a specialized one. On the other hand, the applicant's invention can be used with a conventional camera, any conventional Polaroid camera, and does not require the purchase of a specialized, one function camera.

Under Method #2:

(1st exposure done at 1/2 exposure time, 2nd exposure done at 1 full exposure time)

SIMILAR:

- If the second exposure is a regular, i.e. 1 full exposure time, then a conventional camera can be used with Spector's idea, but a special "viewfinder" is still needed and how that is to happen with a conventional camera is not described in the patent thereby implying, again, the use of a specialized camera.

DISSIMILAR:

- As mentioned in Under Method #1, Spector's use of a special "viewfinder" makes a special camera fitted with such a viewfinder necessary and thus a "conventional" camera cannot be used, whereas the applicant's invention allows use of a conventional camera.

Column 3, Line 1-4

"The film used for this purpose may be in cartridge, reel or in any other conventional form, includes a pack of individual frames as in a "POLAROID" instant camera.

Column 5, Claim 3

"A technique as set forth in claim 1, wherein said camera is an instant camera and said frames are stacked in a pack."

SIMILAR:

- Makes use of Polaroid film, as does the applicant's invention. Applicant claims stacked pack of Polaroid film leads to complicated problems thwarting "the essential spirit" of Spector's invention, i.e. a child can use it (see applicant's comments on page 5, under "Method #2", "SIMILAR" points).

Column 4, Line 25-29:

"In practice, consumers may be provided with a large choice of pre-exposed film cartridges or reels having different characters therein, and with guides appropriate thereto."

SIMILAR:

- The applicant's invention also implies the possibility of having a variety of differing, pre-exposed borders/images.

Column 2, Line 22-25:

"...object of the invention is to provide a book illustrated by a series of pictures taken by the photographic technique..."

DISSIMILAR:

- Spector claims the final purpose of his invention is to create an illustrated book with these photos. The applicant's invention makes no such claim, or limitation.

SUM:

Spector ('832) differs significantly from the applicant's invention. Though the intentions are somewhat similar, (i.e. to produce two contiguous images, one pre-exposed, the other exposed later) their nature and roles differ significantly, as do the method(s) employed to achieve them and the final results. Specifically, Spector's invention is a script. Spector's method does not use masks but employs 1/2 exposure times. Spector's method inevitably leads to problems of double exposure, film saturation and under exposure, problems inherent in his method. The applicant's method employs masking, has none of the problems inherent in Spector's method and is not a self limiting script.

SPECTOR ('224)

All the "SIMILAR" and "DISSIMILAR" points cited above for Spector ('832) apply to this later patent, Spector ('224).

From Title:

CAMERA FOR PRODUCING PICTURES OF INDIVIDUALS JOINTLY WITH CHARACTERS

Abstract:

The camera is loaded with a dual track film having a picture track and a parallel guide track.

DISSIMILAR:

- As the titles suggests, this patent is just an elaboration of Spector's last patent, specifically, the creation of a more specialized camera to take photos by his method in a more fool-proof manner. The only thing that is changing is that now the previously external guide strip has been internalized into the camera and made part of the film itself. All else remains the same between the two inventions. Thus, the camera is now even more specialized than his last patent and still unable to be loaded with regular, non pre-exposed film to take regular pictures. You must use his special camera. The applicant's invention makes use of an ordinary, non specialized camera while Spector does not.

DISSIMILAR:

- Also, the film is now specialized. Before, in Spector's first invention, it was just regular strip film (e.g. Kodak) that was only made special by being pre-exposed. Now, in Spector's second invention, the film strip itself has been redesigned to carry a

transparent strip along the top that acts as an internal guide when viewed through the camera viewfinder; it is now a specialized film. Spector's film can only be used in his cameras; Spector's camera can only be used with his film. Both are no longer "conventional" as previously claimed in prior patent and can't take regular, ordinary pictures. On the other hand, the applicant's invention allows you to use both a conventional, non-specialized camera and a conventional, non-specialized film (it's ordinary Polaroid film that has just only been pre-exposed) meaning you can take regular, normal pictures if you want.

SIMILAR:

All other points mention in Spector ('832) apply here.

DISSIMILAR:

All other points mention in Spector ('832) apply here.

Column 4, Line 5-7:

"The dual-track film (14) used for this purpose which is illustrated in FIG.2, may be in cartridge, reel or in any other conventional form."

DISSIMILAR:

- Spector's specialized film cannot be applied to Polaroid film or cameras. It will only work for reel or cartridge film (e.g. Kodak), not stacked (Polaroid) film. Thus, Spector ('224) does not apply to Polaroid instant pictures (stacked film), only Kodak or similar.

On the other hand, the applicant's invention applies to both Kodak and Polaroid type films and cameras.

Column 5, Line 23-26:

"But by the use of a film of the appropriate sensitivity, the underexposure can be compensated for to provide a picture of acceptable quality."

NOTEWORTHY:

- It is interesting that in Spector's previous patent, ('832), when speaking of overcoming his invention's problem with under exposure, he says using a film of the "appropriate sensitivity" will "provide a picture of good quality" (*Col. 4, Ln 16*), but now, in ('224), it's down to "...a picture of acceptable quality." It's as if Spector, himself, has no faith in overcoming his invention's double exposure under exposure problems.

SUM:

This patent, for the same reasons as Spector ('832), differs significantly from the applicant's patent.

KIRKENDALL ('512)

Title:

FILM CASSETTE CONTAINING PRE-EXPOSED FILM.

Abstract:

During manufacture each frame of a film strip has one portion masked while the frame is exposed to light. Said light impinges on a second portion of the frame to form a latent image.

The film strip is mounted within a camera where the previously unexposed portion of the

frame is exposed to a second image bearing light while the pre-exposed portion of the frame is masked from said second light, the strip of film is removed from the camera to develop the two latent images as a single photograph.

SIMILAR:

- This invention intends to have a pre-exposure and a post exposure appear contiguous on a single frame of film.
- Each successive frame contains a pre-exposure.
- This pre-exposure is done prior to purchase and mounting in the camera.
- Both the pre-exposure and the post exposure are developed simultaneously.
- The pre-exposure is done with masking.
- The post exposure, and protection of the pre-exposure, is done with masking.
- A conventional camera may be used in one of the embodiments of this patent.

DISSIMILAR:

- This patent is designed for strip film, similar to 35mm film, that contains a series of frames on a strip that is wound up on a spool and pre-packaged in a cassette (e.g. Kodak 110 or 126 cassette film) to be loaded in a conventional camera or housed by the manufacture in a "disposable" camera. This patent does not deal with what is called stacked film, i.e. Polaroid film packs.
- This patent focuses on the manufacturing process of pre-exposing the frames of film.
- This patent states "*...each of the film units in the ultimately supplied strip of film units has the same pre-exposed latent image at the same location on each film unit or*

frame." The applicant's invention makes no such stipulation.

- The applicant envisioned the possibility of different patterned borders in one pack.
- This patent makes no mention of creating a whited out zone that would mask or cover any accidental overlapping of the two images should they not be "keyed" or properly aligned with each other.
- This patent makes note of store packaging preferences. This patent makes specific reference to pre-exposure method employing the use of a design bearing "acetate" to transfer the pre-exposure image to the film frame.
- This patent makes specific note of the mechanics of the second mask which frames the second exposure while protecting, masking, the first exposure from the light of this second exposure. The patent mentions various ways of incorporating this mask into the strip film cartridge, the body of the disposable camera itself, and also as an attachable mask mounted by the user.

It is noted that claims 6 and 7 each presents a feature not present in Kirkendall. Thus claim 6 calls for differences in the second exposed portions of the several film items, a concept not in the reference.

Finally, new claim 8 parallels claim 5, adding thereto the substance of claim 6. Thus, it can be said to be a composite of claims 1,2,3,4,5 and 6. No counterpart thereof is in any reference and there is no motivation in the art to select and combine isolated elements. Even if forced, however, the several elements are not all shown, i.e. there is still a gap.

More specifically, if the Examiner will try to complete the following table, it is believed the deficiencies of the cited references will become apparent:

Claim 8

Location of Disclosure in:
Spector '832 Spector '224 Kirkendall

- a) sealed film package
- b) plurality in instant developing film items
- c) each item having
 - i) unexposed portion
 - ii) exposed portion (partly surrounding i)
 - iii) exposed portions undeveloped
 - iv) exposed portions not identical

Other claims contain only some of the features of claim 8 but where in the art do they appear?

Finally there is appended hereto a Declaration under 37 CFR 1.31 identical with that previously filed except that the date recited is prior to the filing dates of the references presently relied upon.

Favorable action is solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required Petition fee to Deposit Account No. 19-3869.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No.

19-3869.

Respectfully submitted,
SPRUNG HORN KRAMER & WOODS

By Leonard Horn
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I hereby certify that this correspondence is being deposited with the United States Postal Services as first class mail in an envelope addressed to The Assistant Commissioner for Patents, Washington, D.C. 20231 on October 19, 1995.

SPRUNG HORN KRAMER & WOODS

Date 10/19/95 By Leonard Horn

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